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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,726	08/28/2001	Rafael Storz	016790-0432	2703
22428	7590	12/03/2003	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				FULLER, RODNEY EVAN
		ART UNIT		PAPER NUMBER
		2851		

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/939,726	STORZ ET AL.	
	<b>Examiner</b> Rodney E Fuller	<b>Art Unit</b> 2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Remarks***

1. In response to applicant's Amendment, dated September 15, 2003, the examiner acknowledges the corrections of the Objections related to the Specification, Drawings and Claims set forth in the Office Action mailed May 13, 2003.
2. The examiner acknowledges the addition of claims 21-28. However, the examiner notes that the applicant has labeled claims 24-28 as "currently amended."
3. Regarding the 35 U.S.C. 112, first paragraph, rejection of claims 1-20, the examiner has considered the applicant's arguments and withdraws the rejection.
4. Regarding the 35 U.S.C. 102(e) 35 U.S.C. 102(e) rejection of claims 1-20 as being anticipated by Maeda, et al. (US 6,556,290), the examiner acknowledges the English language translation of the foreign priority document. Because the priority date of the present application is before the filing date of Maeda, the examiner withdraws the rejection.

### ***Drawings***

5. New corrected drawings are required in this application because the current drawings are informal (i.e., labels in Figure 1, shading in Figures 7 and 8). Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Specification***

6. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the number and nature of the amendments render it difficult to consider the application and/or to arrange the papers for printing or copying.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c).

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Karpol, et al. (US 6,369,888).

As best the examiner is able to ascertain the claimed invention, Karpol discloses all the structure set forth in the claims. On page 2, lines 22-25 of the Summary Of The Invention, the specification states: “*According to the invention, it has been recognized for the first time that disruptive interference phenomena in the optical beam path can be avoided if the coherence length of the light emitted by the laser light source is less than*

*the optical path in the illumination beam path.” Likewise, Karpol discloses (abstract): “... that light beams output by the element combinations have optical path length differences that are greater than a coherence length of the light beam output by the coherent light source.”*

Regarding the claims 23-28, Karpol discloses “...to illuminate an object (Fig. 1A, ref.# 2) with light from a laser light source (Fig. 1A, ref.# 4), comprising a modulator (Fig. 1A, ref.# 30) adapted to vary the phase angle of a light field of the light in such a way that interference phenomena does not occur in an optical beam path of the microscope, or occurs only to an insignificant extent, within a predetermined time interval.” Further, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

The method steps of claims 1-22 are met by the operation of Karpol as applied to claims 23-28.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Mandella, et al. (US 6,201,608), Van de Velde (US 6,186,628) and Almogy (US 6,122,046) each disclose “a confocal scanning microscope adapted to illuminate an object with light from a laser light source, comprising a modulator.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney E Fuller whose telephone number is 703-306-5641. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Rodney E Fuller  
Primary Examiner  
Art Unit 2851



November 24, 2003